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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,493	02/21/2001	Allan Henrik Suonpera	367.39683X00	6757

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EXAMINER

PAN, YUWEN

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,493

Applicant(s)

SUONPERA ET AL.

Examiner

Yuwen Pan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed 3/04/04 have been fully considered but they are not persuasive.

The applicant argues that Piosenka reference doesn't teach the limitation of the applicant's invention in which "relate to make a backup of personalized information stored in a handheld portable phone... store the personalized information in the memory means associated with the data transfer application in the computer". First of all, the applicant keeps emphasizing the word "backup" in the remark. The examiner double review the listing claims and found no word of "backup". The examiner presumes that the applicant defines transferring personalized information between two handheld portable phones in which have memory means as a process of backup. The examiner concurs that it reads on the definition of backup however it could be interpreted as just data information exchange between two portable devices. For instance, business information exchange between two PDAs in which both PDAs inherently have memory means to store data information. Back to Piosnka reference, Piosnaka teaches not only to send information from a computer to a cellular telephone but also to send data information from the cellular phone to the computer (see column 7 and line 39-column 8 and line 12).

The applicant further argues that Piosenka reference doesn't teach controlling a data transfer application on a computer to read personalized information from memory means of a handheld portable phone and store this personalized information in a memory means of a computer. The examiner respectfully disagrees because Piosenka clearly teaches that (see column 9 and line 31-column 10 and line 6).

The applicant further argues that Bernd reference teaches only common data and is not personalized information. The examiner agrees however the reasoning of combine Bernd reference with Piosenka is not because of whether both reference teaches transmitting similar data format or information. Since either personalized information or common data is just data information, it would have been obvious to one ordinary skill in the art to make the combination. Furthermore, Piosenka teaches manually select personalized information to be stored (see column 9 and line 55-column 10 and line 6).

Based on aforementioned reasoning, the rejection sustains.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Piosenka et al (EP000827353A2).

With respect to claims 6 and 10, Piosenka discloses a method and computer program of transferring personalized information from one hand portable phone having a memory means for storing said personalized information to a computer on which a data transfer application is running (see column 7 and lines 39-44), comprising:

Establishing a connection between said first hand portable phone and said computer (see figure 1),

Controlling the data transfer application on the computer to read said personalized information, such as phone books, from said first memory means for storing said personalized information in said first hand portable phone to memory means associated with said data transfer application in the computer and allow user to individually select the type of personalized information to be corrected or updated prior to further transferring (see figure 5 - 7, column 8 and lines 36-52).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3,5,7,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al (EP000827353A2) in view of Bernd et al (GB2313519).

With respect to claims 1 and 7, Piosenka discloses a method and program product of transferring personalized information from one hand portable phone having a memory means for storing said personalized information to a computer on which a data transfer application is running (see column 7 and lines 39-44), comprising:

Establishing a connection between said first hand portable phone and said computer (see figure 1),

Controlling the data transfer application on the computer to read said personalized information, such as phone books, from said first memory means for storing said personalized information in said first hand portable phone to memory means associated with said data transfer

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application in the computer and allow user to individually select the type of personalized information to be corrected or updated prior to further transferring (see figure 5 - 7, column 8 and lines 36-52);

Piosenka doesn't disclose a second hand portable in which connect to the computer in order to receive the personalized information that has downloaded from the first portable phone.

Bernd discloses a radio communication system in which comprises a first radio unit, a second radio unit and a computer such that the first radio unit is able to transfer data information from a first memory means for storing data to a second memory means for storing data of the second radio unit via a middle person, the computer (see figure 3, see page 4 and lines 6-34).

It would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teach of Bernd with Piosenka's system and device such that a user is able to save or transfer important personal information from one radio unit to a intermediate or second radio unit for modification, storage, and upgrade.

With respect to claim 2, Picosenka further discloses that the personalized information includes phone numbers, message content, profile setting, and cell setting and service settings (see column 1 and lines 10-15, column 2 and lines 5-10).

With respect to claim 3, Picosenka further discloses that the established connection between the computer and phone is a wire-based data connection (see column 7 and lines 24-38).

With respect to claim 5 and 9, Piosenka further discloses that the user is allowed to individually select the type of personalized information to be read from the first memory means prior to the initializing of the data transfer (see column 8 and lines 36-53).

5. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al (EP000827353A2) and Bernd et al (GB2313519) as applied to claim 1 above, and further in view of Ishigami (US006625445B1).

Combination of Piosenka and Bernd discloses an analogous system as recited in claim 1. Combination of Piosenka and Bernd doesn't teach a step of evaluating the capabilities of the phones to receive the data information.

Ishigami discloses that a system that transferring a plurality of data from a computer to a portable phone in which determine whether the portable phone is capable to receive such plurality of data (see column 2 and lines 12-22).

It would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teaching of Ishigami with the combination of Piosenka and Bernd such that no plurality of data would be transferred until the receiving party is ready and avoid error and overload the receiving party.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuwen Pan whose telephone number is 703-305-7372. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yuwen Pan
May 12, 2004


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
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5/17/04